

REMARKS

Claims 32 to 37 are added, and therefore claims 14, 16 to 18, and 20 to 37 are pending in the present application.

In view of the following remarks, Applicants respectfully submit that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

This RCE Amendment is being filed in lieu of the Appeal Brief first due on November 25, 2009.

Claims 14, 16 to 18, 20, 26 to 28, 30 and 31 are rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Japanese Patent Application Publication No. 2001-119451 (“Andreas”) in view of U.S. Patent No. 7,126,583 (“Breed”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 14 is to a method for providing the services in a speed-dependent manner, in which at least one service uses at least one input medium, in which at least one

service uses at least one output medium, including *at least one video output medium that includes at least two display adaptations of one service, while in an active state*, in which the providing of the services includes providing at least one of a control of a selection of the services and a representation of the services on a user interface present in the motor vehicle, and *performing a speed-dependent adaptation of the at least one video output medium from one active state to another active state*.

The Final Office Action admits that Andreas does not disclose the feature of “*at least one video output medium that includes at least two display adaptations of one service*”, and that Andreas does not disclose the feature of “*performing a speed-dependent adaptation of the at least one video output medium from one active state to another active state*.” As to the secondary Breed reference, it also does not disclose these features. Nowhere in Breed is any speed-dependent action taken.

For example, the Office action cites col. 14, lines 38 to 67, and col. 15, lines 1 to 4, stating that “they are used to help in speed situations”, and cites col. 14, since it supposedly “provide[s] a heads up display which is only illuminated when it is in use.” This simply does not disclose a speed-dependent adaptation of a video output -- nor of anything speed-dependent. In particular, col. 15 states that it “provide[s] a heads up display and touch pad or voice input system for a vehicle to permit the vehicle operator to dial a phone number on a cellular phone without taking his eyes from the road.” Even if this may improve driver safety, it does not perform any function as a speed-dependent adaptation of a video output, as provided for in the context of the presently claimed subject matter.

Absolutely no part of Breed discloses the feature of “*performing a speed-dependent adaptation of the at least one video output medium from one active state to another active state*”, as provided for in the context of the presently claimed subject matter.

As to “*at least one video output medium that includes at least two display adaptations of one service, while in an active state*,” the cited text at col. 16, lines 38 to 67, only states the following:

The vehicle can also include determining means for determining a desired location of the eyes of the occupant relative to the projected text and/or graphics (possibly via a determination of the position of the occupant's head and then using tables to approximate the location of the eyes) and **adjustment means coupled to a seat of the vehicle on which the occupant is situated for adjusting the seat** based on the determined desired location of the eyes of the occupant to

thereby move the occupant and thus the occupant's eyes and enable the occupant's view of the projected text and/or graphics to be improved . . .

Instead of adjusting the seat, the projecting means can be adjusted based on the desired **location of the occupant's eyes relative to the text and/or graphics**. That is, adjustment means are coupled to the projecting means for adjusting the projecting means based on the determined desired **location of the eyes of the occupant relative to the projected text and/or graphics** to thereby **enable the occupant's view of the projected text and/or graphics to be improved**.

The first paragraph, is clearly irrelevant, since the only adjustment is performed on the occupant seat -- and not on a "video output medium." As to the second paragraph, nowhere in this section is there any mention of changing text or graphics. Only the *position* of the projection is changed relative to the eyes of the occupant, so as to put the fixed text/graphics in the occupants field of vision. Whether the *fixed* image is located at point "A" in the vehicle, or located at point "B" in the vehicle is irrelevant to "*at least two display adaptations of one service, while in an active state.*" There is no disclosure that the display is changed at all if in one position or the other.

Accordingly, Andreas and Breed, whether taken alone or combined, does not disclose or suggest all of the features of claim 14, so that claim 14 is allowable, as are its dependent claims 16 to 18, 20, 27, 28, 30, and 31.

Claims 26 includes subject matter like that of claim 14, so that claim 26 is allowable for essentially the same reasons as claim 14.

Withdrawal of this obviousness rejections of claims 14, 16 to 18, 20, 26 to 28, 30 and 31 is therefore respectfully requested.

Claims 21 and 29 are rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Breed, and in further view of U.S. Patent No. 6,714,860 ("Wawra").

Claims 21 and 29 depend from claim 14, and they are therefore allowable for at least the same reasons as claim 14, since Wawra does not cure -- and is not asserted to cure -- the deficiencies of Andreas in view of Breed, as explained above as to claim 14.

Withdrawal of the obviousness rejections of claims 21 and 29 is therefore respectfully requested.

Claim 23 is rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Breed, and in further view of Japanese Patent Application Publication No. 60-61923 ("Toshio").

Claim 23 depends from claim 14, and it is therefore allowable for at least the same reasons as claim 14, since Toshio does not cure -- and is not asserted to cure -- the deficiencies of Andreas in view of Breed, as explained above as to claim 14.

Withdrawal of the obviousness rejection of claim 23 is therefore respectfully requested.

Claim 24 is rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Breed, and in further view of U.S. Patent No. 6,973,333 ("O'Neil").

Claim 24 depends from claim 14, and it is therefore allowable for at least the same reasons as claim 14, since O'Neil does not cure -- and is not asserted to cure -- the deficiencies of Andreas in view of Breed, as explained above as to claim 14.

Withdrawal of the obviousness rejection of claim 24 is therefore respectfully requested.

Claim 25 is rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Breed, and in further view of U.S. Patent No. 6,667,726 ("Daminani").

Claim 25 includes subject matter like that of claim 14, and it is therefore allowable for essentially the same reasons as claim 14, since Damiani does not cure -- and is not asserted to cure -- the deficiencies of Andreas in view of Breed, as explained above as to claim 14.

Withdrawal of the obviousness rejection of claim 25 is therefore respectfully requested.

As further regards each of the obviousness rejections, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office's generalized assertions that it would have been obvious to

modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Answer reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Office Actions to date offer no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met

thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

Also, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a

motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that the reference simply does not describe the features discussed above of the rejected claims.

Thus, the proper evidence of obviousness must show why there is a suggestion as to the reference so as to provide the subject matter of the claimed subject matter and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As still further regards all of the obviousness rejections of the claims, it is respectfully submitted that a proper *prima facie* case has not been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for

example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper *prima facie* unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103

rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 14, 16 to 18, and 20 to 31 are allowable.

New claims 32 to 37 do not add any new matter and are supported by the present application, including the specification. Claims 32 to 37 depend from claim 14, and they are therefore allowable for the same reasons.

Accordingly, claims 14, 16 to 18, and 20 to 37 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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